

### **REMARKS**

By this amendment, Applicants amend claim 88 to address the Examiner's objection due to an informality. Accordingly, Applicants request that the objection to claim 88 be withdrawn. Claims 18-27, 50-59, 69, 70, 76, 77, 79, 81, 83-86, and 88-91 remain pending in this application.

In the Office Action<sup>1</sup>, the Examiner rejected claims 18-22, 26, 50-59, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King et al. (U.S. Patent Application Publication No. 2002/0002590) in view of Whitehouse (U.S. Patent No. 5,341,505); rejected claims 23-25, 27, 55-57, 59, 70, 77, 81, 85, 88, 90, and 91 under 35 U.S.C. § 102(e) as being anticipated by King; and rejected claims 83 and 89 under 35 U.S.C. § 103(a) as being unpatentable over King.

#### **I. REJECTION OF CLAIMS 18-22, 26, 50-59, 69, 76, 79, AND 86 UNDER § 103(a)**

Applicants respectfully traverse the rejection of claims 18-22, 26, 50-59, 69, 76, 79, and 86 under 35 U.S.C. § 103(a) as being unpatentable over King in view of Whitehouse. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original). In this application, a *prima facie* case of obviousness has not been established because the prior art does not render obvious the claims.

Independent claim 18 recites “receiving the message directed to the user with the electronic account, where the **message** includes an **electronic address** associated with the user’s electronic account **and a non-standardized physical address** of the user” and “determining a **standardized physical address** of the user from the electronic address using an address database” (emphases added). The applied prior art does not render obvious at least these elements of claim 18.

According to the King system, a sender manually enters a physical address of a recipient or chooses a physical address of the recipient, as well as enters an email address of the recipient to send a message. King at paragraph [018]. If the sender does not know the recipient’s physical address, then the physical address can be determined by “searching based on the recipient’s telephone number, zip code, state, or by any other information that is useful in the event that the sender does not know the physical address of the recipient.” *See Id.* at paragraph [0022]. Thus, the message

taught by King includes an email address and a physical address of the recipient. However, such a message does not render obvious Applicants' claimed "message," which includes "an **electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user," as recited in claim 18 (emphases added). Nor does such a message render obvious "determining a **standardized physical address** of the user from the electronic address using an address database," as recited in claim 18 (emphasis added), because the message in King already includes a physical address and, accordingly, there is no need or reason to determine a standardized physical address.

The Examiner cites page 2, paragraphs 22 and 23 of King for an alleged teaching of the above-recited claim elements. The Examiner's allegation is incorrect. As noted above, according to King, if the sender does not know the recipient's physical address, then the physical address can be determined by "searching based on the recipient's telephone number, zip code, state, or by any other information that is useful in the event that the sender does not know the physical address of the recipient." See Id. at paragraph [0022]. Such a disclosure does not render obvious "receiving the message directed to the user with the electronic account, where the **message** includes an **electronic address** associated with the user's electronic account **and a non-standardized physical address** of the user," as recited in claim 18. In particular, such a disclosure does not teach, suggest, or render obvious the claimed "message" because, at most, King teaches searching for the physical address for inclusion in an email message.

As noted above, King discloses searching for a physical address. Since the message in King includes a physical address, either entered by the sender or searched for by the sender, such searching does not teach or suggest a “message,” which includes “an **electronic address** associated with the user’s electronic account **and a non-standardized physical address** of the user” and “determining a **standardized physical address** of the user from the electronic address using an address database,” as recited in claim 18 (emphases added). That is, because the King message includes a physical address in its original form, there is no reason to include a non-standardized physical address in the message. As discussed, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, internal citations omitted (emphasis in original). Accordingly, Applicants’ claimed invention as a whole would not be obvious in view of the cited prior art because the Examiner merely selects differences between King and the claimed invention, but does not provide a reason why one of ordinary skill in the art, at the time the invention was made, would modify King in a manner contrary to its purpose. Moreover, the Examiner has not identified any predictability or reasonable expectation of success of such a modification.

Whitehouse, which was cited for allegedly supporting the obviousness of using “9 digit zip codes” (Office Action at page 3) does not overcome the deficiencies of King. That is, Whitehouse also does not teach, suggest, or render obvious “receiving the message directed to the user with the electronic account, where the **message** includes an **electronic address** associated with the user’s

electronic account **and a non-standardized physical address** of the user” and “determining a **standardized physical address** of the user from the electronic address using an address database,” as recited in independent claim 18 (emphases added).

For at least the above reasons, the prior art does not render obvious claim 18 and a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 18 under 35 U.S.C. § 103(a).

Independent claims 50, 55, 69, 76, 79, and 86, although of a different scope from each other and claim 18, each include recitations that are similar to claim 18. Accordingly, the prior art does not render obvious claims 50, 55, 69, 76, 79, and 86 for at least the same reasons discussed above and a *prima facie* case of obviousness has not been established. Therefore, for at least the above reasons, the Examiner should also withdraw the rejection of claims 50, 55, 69, 76, 79, and 86 under 35 U.S.C. § 103(a).

Each of dependent claims 19-22, 26, 51-54, and 56-59 depend from one of allowable independent claims 18, 50, 55, 69, 76, 79, and 86, and are allowable at least due to their dependence. Accordingly, the Examiner should also withdraw the rejection of dependent claims 19-22, 26, 51-54, and 56-59 under 35 U.S.C. § 103(a).

## **II. REJECTION OF CLAIMS 23-25, 27, 55-57, 59, 70, 77, 81, 85, 88, 90, AND 91 UNDER § 102(e)**

Applicants respectfully traverse the rejection of claims 23-25, 27, 55-57, 59, 70, 77, 81, 85, 88, 90, and 91 under 35 U.S.C. § 102(e) as being anticipated by King. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the

presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131.

Independent claim 23 recites “receiving the message directed to the user with the electronic account, where the message includes a non-standardized electronic address of the user and a physical address of the user” and “determining a standardized electronic address of the user from the physical address using an address database.” King does not teach at least these elements of independent claim 23 for similar reasons given above. Independent claims 55, 77, 81, and 88, although of a different scope from each other and claim 18, each include recitations that are similar to claim 18. Accordingly, the prior art does not teach each and every element of claims 55, 77, 81, 88 for at least the same reasons discussed above. Therefore, the Examiner should also withdraw the rejection of claims 55, 77, 81, and 88 under 35 U.S.C. § 102(e).

Each of dependent claims 24, 25, 27, 56, 57, 59, 70, 85, 90, and 91 depend from one of the allowable independent claims, and are allowable at least due to their dependence. Accordingly, the Examiner should also withdraw the rejection of dependent claims 24, 25, 27, 56, 57, 59, 70, 85, 90, and 91 under 35 U.S.C. § 102(e).

**III. REJECTION OF CLAIMS 83 AND 89 UNDER § 103(a)**

Applicants respectfully traverse the rejection of claims 83 and 89 under 35 U.S.C. § 103(a) as being unpatentable over King. Claims 83 and 89 depend from allowable independent claim 81 and are allowable at least due to their dependence for reasons discussed above.

**CONCLUSION**

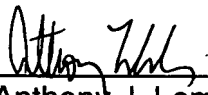
Applicants respectfully request reconsideration of the application, withdrawal of the claim rejections, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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